

AUS920010833US1

**REMARKS**

Claims 1-55 are in the case. Newly added claim 55 claims a method for identifying a call context for a call on behalf of another that includes:

- receiving, by a context inference service, a request for a call context for a call;
- receiving, by the context inference service, call context information associated with at least one from among a caller and a callee associated with said call;
- analyzing, by the context inference service, the call context information;
- inferring, by the context inference service in dependence upon the call context information, the identity of at least one party to the call and a subject matter surrounding the call;
- inferring, by the context inference service in dependence upon the identity of at least one party to the call and the subject matter surrounding the call, that an on behalf of action is invoked for said call; and
- sending, from the context inference service, a call context for the call including an indication that an on behalf of action is invoked for said call.

As demonstrated below, claim 55 is patentable and should be allowed.

Claims 1-11, 14, 17-22, 32-36, and 45-48 stand rejected under 35 U.S.C § 102(b) as being anticipated by Szlam (U.S. Patent No. 5,511,112). Claims 12-13, 15-16, 23-24, 31, and 37-38 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112). Claims 25-30, 39-44, and 49 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam (U.S. Patent No.

AUS920010833US1

5,511,112) in view of Borland (U.S. Patent 6,178,230). Claims 50-54 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Farris *et al.* (U.S. Patent No. 6,122,357). As will be shown below, Szlam, alone or in combination with Borland or Farris, does not anticipate methods, systems, and products of the present invention. Claims 1-55 are therefore patententable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-55.

### REJECTION UNDER 35 U.S.C. § 102 OVER SZLAM

Claims 1-11, 14, 17-22, 32-36, and 45-48 stand rejected under 35 U.S.C § 102(b) as being anticipated by Szlam (U.S. Patent No. 5,511,112). To anticipate claims 1-11, 14, 17-22, 32-36, and 45-48 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Szlam must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Szlam must enable Applicants' claims. Szlam does not meet either requirement and therefore does not anticipate Applicants' claims.

#### Szlam Does Not Disclose Each and Every Element Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Newly added independent claim 55 claims:

A method for identifying a call context for a call on behalf of another, said method comprising:

receiving, by a context inference service, a request for a call context for a call;

AUS920010833US1

receiving, by the context inference service, call context information associated with at least one from among a caller and a callee associated with said call;

analyzing, by the context inference service, the call context information;

inferring, by the context inference service in dependence upon the call context information, the identity of at least one party to the call and a subject matter surrounding the call;

inferring, by the context inference service in dependence upon the identity of at least one party to the call and the subject matter surrounding the call, that an on behalf of action is invoked for said call; and

sending, from the context inference service, a call context for the call including an indication that an on behalf of action is invoked for said call.

Szlam does not disclose each and every element of newly added claim 55. Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Depending upon the status of the call the agent may specify that the call has been essentially completed or that the agent is on hold. *See for example*, U.S. Patent No. 5, 511,112, Szlam, abstract; Figure 1; Figure 6; column 7, lines 23-24; column 17; lines 50-67. Szlam does not disclose identifying a call context for a call on behalf of another as claimed in claim 55. In fact, Szlam does not even mention, for example, "a context inference services," "call context information," the "subject matter surrounding the call, or an "on behalf of action." Newly added claim 55 is therefore patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or

AUS920010833US1

receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not identifying a call context for a call on behalf of another by inferring, by the context inference service in dependence upon the identity of at least one party to the call and the subject matter surrounding the call, that an on behalf of action is invoked for said call and sending, from the context inference service, a call context for the call including an indication that an on behalf of action is invoked for said call as claimed in newly added claim 55. As such newly added claim 55 is patentable and should be allowed.

Independent Claim 1

Turning now to rejected claims 1-11, 14, 17-22, 32-36, and 45-48. Independent claim 1 claims a method for identifying a context for a call including detecting a call request for a call and requesting a context for said call, wherein said context indicates whether an on behalf of action is invoked for said call. Szlam does not disclose each and every element of claim 1. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose identifying a context for a call as claimed in claim 1 including detecting a call request for a call and requesting a context for said call, wherein said context indicates whether an on behalf of action is invoked for said call. In fact, Szlam does not even mention "requesting a context for a call" or a "context indicates whether an on behalf of action is invoked for said call." Claim 1 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not a call context that indicates whether an on

AUS920010833US1

behalf of action is invoked for the call. As such, claim 1 is patentable and should be allowed.

Independent Claim 11

Independent claim 11 claims a method for determining a call context that includes receiving a call context request for a call; analyzing call context information associated with at least one from among a caller and a callee associated with said call; and inferring that an on behalf of action is invoked for said call from call context information. Szlam does not disclose each and every element of claim 11. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, analyzing call context information associated with at least one from among a caller and a callee associated with said call; and inferring that an on behalf of action is invoked for said call from call context information. In fact, Szlam does not even mention "inferring that an on behalf of action is invoked for said call from call context information". Claim 11 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not inferring that an on behalf of action is invoked for said call from call context information as claimed in claim 11. As such, claim 11 is patentable and should be allowed.

Independent Claim 14

Independent claim 14 claims a method for identifying parties to a call that includes detecting a call between at least two parties; detecting an on behalf of action invoked for

AUS920010833US1

said call; and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call. Szlam does not disclose each and every element of claim 14. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, "detecting an on behalf of action invoked for said call" and "informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." In fact, Szlam does not even mention detecting an on behalf of action invoked for said call and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." Claim 14 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not identifying parties to a call that includes detecting an on behalf of action invoked for said call and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call as claimed in claim 14. As such, claim 14 is patentable and should be allowed.

#### Independent Claim 17

Independent claim 17 claims a method for determining a call context that includes analyzing call context information associated with said call and determining whether an on behalf of action is invoked for said call from said call context information. Szlam does not disclose each and every element of claim 17. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call

AUS920010833US1

is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, "detecting an on behalf of action invoked for said call" and "informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." Claim 17 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not identifying parties to a call by detecting an on behalf of action invoked for said call and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call. As such, claim 17 is also patentable and should be allowed.

#### System and Computer Program Product Claims

Independent claims 5, 9, 12, 13, 15, 16, 31 and 45 claim system and computer program product aspects of the methods claimed in claims 1, 11, 14, and 17. Claims 5, 9, 12, 13, 14, 15, 16, 31 and 45 stand rejected for the same reasons as claims 1, 11, 14, and 17. As discussed above, Szlam does not disclose each and every element of claims 1, 11, 14, and 17. For the same reasons, Szlam also does not disclose each and every element of claims 5, 9, 12, 13, 14, 15, 16, 31 and 45. Claims 5, 9, 12, 13, 14, 15, 16, 31 and 45 are patentable and should be allowed.

#### Dependent Claims

Dependent claims 2-4, 6-8, 10, 18-30, 32-44, 46-50 depend respectively from independent claims 1, 5, 9, 11, 17, 31 and 45. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand. As such, claims 2-4, 6-8, 10, 18-30, 32-44, 46-50 are patentable and should be allowed.

AUS920010833US1

Szlam Does Not Enable Each and Every Element  
Of The Claims Of The Present Application

Not only must Szlam disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Szlam must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Szlam places Applicants' claims in the possession of a person of ordinary skill in the art, Szlam is legally insufficient to anticipate Applicants' claims under 35 USC 102(b).

Szlam does not place one of ordinary skill in the art in possession of claim 55. Newly added independent claim 55 claims:

A method for identifying a call context for a call on behalf of another, said method comprising:

receiving, by a context inference service, a request for a call context for a call;

receiving, by the context inference service, call context information associated with at least one from among a caller and a callee associated with said call;



AUS920010833US1

analyzing, by the context inference service, the call context information;

inferring, by the context inference service in dependence upon the call context information, the identity of at least one party to the call and a subject matter surrounding the call;

inferring, by the context inference service in dependence upon the identity of at least one party to the call and the subject matter surrounding the call, that an on behalf of action is invoked for said call; and

sending, from the context inference service, a call context for the call including an indication that an on behalf of action is invoked for said call.

Szlam does not place one of skill in the art in possession of claim 55. Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Depending upon the status of the call the agent may specify that the call has been essentially completed or that the agent is on hold. *See for example*, U.S. Patent No. 5, 511,112, Szlam, abstract; Figure 1; Figure 6; column 7, lines 23-24; column 17; lines 50-67. Szlam does not disclose identifying a call context for a call on behalf of another as claimed in claim 55. In fact, Szlam does not even mention, for example, "a context inference services," "call context information," the "subject matter surrounding the call, or an "on behalf of action." Szlam therefore does not enable claim 55. Newly added claim 55 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not identifying a call context for a call on behalf of another by inferring, by the context inference service in dependence upon the identity

AUS920010833US1

of at least one party to the call and the subject matter surrounding the call, that an on behalf of action is invoked for said call and sending, from the context inference service, a call context for the call including an indication that an on behalf of action is invoked for said call as claimed in newly added claim 55. As such, Szlam does not place one of skill in the art in possession of claim 55. Newly added claim 55 is patentable and should be allowed.

#### Independent Claim 1

Turning now to rejected claims 1-11, 14, 17-22, 32-36, and 45-48. Independent claim 1 claims a method for identifying a context for a call including detecting a call request for a call and requesting a context for said call, wherein said context indicates whether an on behalf of action is invoked for said call. Szlam does not place one of skill in the art in possession of claim 1. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose identifying a context for a call as claimed in claim 1 including detecting a call request for a call and requesting a context for said call, wherein said context indicates whether an on behalf of action is invoked for said call. In fact, Szlam does not even mention "requesting a context for a call" or a "context indicates whether an on behalf of action is invoked for said call." Szlam therefore does not enable claim 1. Claim 1 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 -- column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not a call context that indicates whether an on behalf of action is invoked for the call. Szlam therefore does not place one of skill in the art in possession of claim 1. As such, claim 1 is patentable and should be allowed.

AUS920010833US1

Independent Claim 11

Independent claim 11 claims a method for determining a call context that includes receiving a call context request for a call; analyzing call context information associated with at least one from among a caller and a callee associated with said call; and inferring that an on behalf of action is invoked for said call from call context information. Szlam does not place one of skill in the art in possession of claim 11. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, analyzing call context information associated with at least one from among a caller and a callee associated with said call; and inferring that an on behalf of action is invoked for said call from call context information. In fact, Szlam does not even mention "inferring that an on behalf of action is invoked for said call from call context information". Szlam therefore does not enable claim 11. Claim 11 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not inferring that an on behalf of action is invoked for said call from call context information as claimed in claim 11. Szlam does not place one of skill in the art in possession of claim 11. As such, claim 11 is patentable and should be allowed.

Independent Claim 14

Independent claim 14 claims a method for identifying parties to a call that includes detecting a call between at least two parties; detecting an on behalf of action invoked for said call; and informing at least one party to said call that said on behalf of action is

AUS920010833US1

invoked, such that an on behalf of party is also indicated for said call. Szlam does not place one of skill in the art in possession of claim 14. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, "detecting an on behalf of action invoked for said call" and "informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." In fact, Szlam does not even mention detecting an on behalf of action invoked for said call and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." Szlam therefore does not enable claim 14. Claim 14 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not identifying parties to a call that includes detecting an on behalf of action invoked for said call and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call as claimed in claim 14. Szlam does not place one of skill in the art in possession of claim 14. As such, claim 14 is patentable and should be allowed.

#### Independent Claim 17

Independent claim 17 claims a method for determining a call context that includes analyzing call context information associated with said call and determining whether an on behalf of action is invoked for said call from said call context information. Szlam does not place one of skill in the art in possession of claim 17. As discussed above, Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of

AUS920010833US1

the call is appropriate after an agent has been connected to a call. Szlam does not disclose, for example, "detecting an on behalf of action invoked for said call" and "informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call." Szlam therefore does not enable claim 17. Claim 17 is patentable and should be allowed.

The office action states that Szlam discloses an on behalf of action at column 12, lines 67 – column 13, line 4 and column 17, lines 56-59. The cited sections of Szlam actually disclose that an agent may also be placed on hold when a party's secretary places or receives the call and once connected ask the agent to please hold for that party. Asking an agent to hold as disclosed in Szlam is not identifying parties to a call by detecting an on behalf of action invoked for said call and informing at least one party to said call that said on behalf of action is invoked, such that an on behalf of party is also indicated for said call. Szlam does not place one of skill in the art in possession of claim 17. As such, claim 17 is also patentable and should be allowed.

#### System and Computer Program Product Claims

Independent claims 5, 9, 12, 13, 15, 16, 31 and 45 claim system and computer program product aspects of the methods claimed in claims 1, 11, 14, and 17. Claims 5, 9, 12, 13, 14, 15, 16, 31 and 45 stand rejected for the same reasons as claims 1, 11, 14, and 17. As discussed above, Szlam does not place one of ordinary skill in the art in possession of claims 1, 11, 14, and 17. For the same reasons, Szlam also does not place one of ordinary skill in the art in possession of claims 5, 9, 12, 13, 14, 15, 16, 31 and 45. Claims 5, 9, 12, 13, 14, 15, 16, 31 and 45 are patentable and should be allowed.

#### Dependent Claims

Dependent claims 2-4, 6-8, 10, 18-30, 32-44, 46-50 depend respectively from independent claims 1, 5, 9, 11, 17, 31 and 45. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent

AUS920010833US1

claims stand because their respective independent claims stand. As such, claims 2-4, 6-8, 10, 18-30, 32-44, 46-50 are patentable and should be allowed.

### REJECTION UNDER 35 U.S.C. § 103(a) OVER SZLAM

Claims 1-54 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Szlam (U.S. Patent No. 5,511,112) or Szlam (U.S. Patent No. 5,511,112) in view of Borland (U.S. Patent 6,178,230) and in further view of Farris *et al.* (U.S. Patent No. 6,122,357). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to modify Szlam or to combine Szlam and Borland and Farris. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed modification of Szlam or the proposed combination of Szlam and Borland and Farris. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed modification of Szlam or the proposed combination of Szlam and Borland and Farris must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, neither the modification of Szlam, nor the combinations of Szlam and Borland and Farris establishes a prima facie case of obviousness. The rejection of claims 1-54 should therefore be withdrawn and the case should be allowed.

### SZLAM

Claims 12-13, 15-16, 23-24, 31, and 37-38 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112). The Office Action admits that Szlam does not suggest a contest inference server. The Office Action rejects claims 12-13, 15-16, 23-24, 31, and 37-38 stating only that "it would have been

AUS920010833US1

obvious to one of ordinary skill in the art at the time the invention was made to modify Szlam's controller to include an inference server for the purpose of storing and retrieving the context information to infer that a call includes an on behalf of action." Applicants respectfully propose, however, that a naked assertion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Szlam's controller to include an inference server is insufficient to support an obviousness rejection.

As stated above, to establish a prima facie case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to modify Szlam. In addition, the Examiner must explicitly point to the teaching within Szlam suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. The Office Action states no rationale for motivation to modify Szlam other than the assertion that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Szlam's controller to include an inference server for the purpose of storing and retrieving the context information to infer that a call includes an on behalf of action." The Examiner does not cite Szlam to support the assertion that modifying Szlam would have been obvious to one skilled in the art. Absent such a showing, the rejection is improper and should be withdrawn. As such, the modification of Szlam cannot support a prima facie case of obviousness and the rejection should be withdrawn.

#### SZLAM AND BORLAND

Claims 30-33, 35-38, and 40 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Borland (U.S. Patent 6,178,230). Claims 30-33, 35-38, and 40 depend respectively from independent claims 29, 34, and 39. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Szlam and Borland does not disclose or suggest each and every element of the independent claims

AUS920010833US1

and no other references refer to the elements of the independent claims, no proposed combination of references can possibly disclose or suggest each and every element of any dependent claim. The rejections of claims 30-33, 35-38, and 40 therefore should be withdrawn, and these claims also should be allowed.

Turning now to the substance of Borland, Borland actually teaches away from on behalf of actions as claimed in the present invention. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Borland discloses an individualized distinctive telephone ring to identify a particular callee. Borland, Col 3, lines 60-65. The telephone ring is individualized and distinctive for a particular callee and therefore is an action on behalf of the callee—not an action on behalf of another. As such, Borland teaches away from actions on behalf of others by teaching telephone rings individualized for a particular callee. Because Borland teaches away from on behalf of actions, the proposed modification cannot support a prima facie case of obviousness. The rejection of Applicants' claims should be withdrawn and the case should be allowed.

#### SZLAM AND FARRIS

Claims 50-54 stand rejected under 35 U.S.C § 103(a) as unpatentable over Szlam (U.S. Patent No. 5,511,112) in view of Farris, *et al* (U.S. Patent No. 6,122,357). The proposed combination cannot establish a prima facie case of obviousness.

#### No Suggestion Or Motivation To Combine

##### Szlam And Farris

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Szlam and Farris. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). There is no suggestion or motivation to combine Szlam and Farris. In



AUS920010833US1

support of an obviousness rejection, the Examiner must explicitly point to the teaching within Szlam or Farris suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. The Office Action states no rationale for motivation to combine Szlam and Farris other than the assertion that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporated the feature of graphically displaying at least one on behalf of party authorized for a party utilizing a telephony device and updating a context for a call based on the selection of the on behalf of party, in Szlam's system, in order to have the latest on behalf of action of the call on the context." The Examiner does not cite Szlam or Farris to support the assertion that combining Szlam and Farris would have been obvious to one skilled in the art. Absent such a showing, the rejection is improper and should be withdrawn. As such, the combination of Szlam and Farris cannot support a prima facie case of obviousness and the rejection should be withdrawn.

The Combination Of Szlam And Farris  
Do Not Teach All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Szlam and Farris must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 50 claims a "method for controlling a telephony device," including "graphically displaying at least one on behalf of party authorized for a party utilizing a telephony device; and detecting a selection from among said at least one on behalf of party; and automatically updating a context for a call to indicate an on behalf of action invoked by said party for said selection from among said at least one on behalf of party." Szlam discloses improving agent efficiency by reducing non-productive time such as time on hold and time for wrap-up statements by determining that automated handling of the call is appropriate after an agent has been connected to a call. Depending upon the status of the call the agent may specify that the call has been essentially completed or that the agent is on hold. *See for example*, U.S. Patent No. 5, 511,112, Szlam, abstract; Figure 1; Figure 6; column 7, lines 23-24; column

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17; lines 50-67. Farris does not correct the deficiencies of Szlam. Farris discloses double voice identification of calling and answering parties. *See for example*, U.S. Patent No. 6, 122, 357, Farris, abstract. Neither Szlam nor Farris discloses graphically displaying at least one on behalf of party authorized for a party utilizing a telephony device, and detecting a selection from among said at least one on behalf of party, and automatically updating a context for a call to indicate an on behalf of action invoked by said party for said selection from among said at least one on behalf of party. In fact, neither Szlam nor Farris does not even mention, for example, "an on behalf of party." As such, the combination of Szlam and Farris cannot establish a prima facie case of obviousness and the rejection should be withdrawn.

#### Conclusion

Claims 1-11, 14, 17-22, 32-36, and 45-48 stand rejected under 35 U.S.C § 102(b) as being anticipated by Szlam. Szlam does not disclose each and every element of Applicants' claims and do not enable Applicants' claims. Claims 12-13, 15-16, 23-24, 25-30, 31, 37-38, 39-44, 49 and 50-54 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Szlam and Szlam in view of Borland and in further view of Farris. For the reasons set forth above, however, the proposed modification of Szlam in view of Borland and in further view of Farris fails to establish a prima facie case of obviousness. The rejection of claims 12-13, 15-16, 23-24, 25-30, 31, 37-38, 39-44, 49 and 50-54 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-55 in light of the present remarks is respectfully requested.

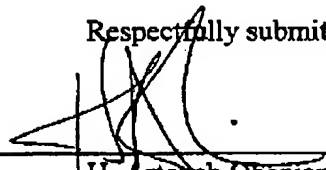
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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447  
for any fees required or overpaid.

Respectfully submitted,

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By: \_\_\_\_\_

  
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